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REMARKS

This is a full and timely response to the outstanding final Office Action mailed March 31, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1, 4-24, and 30

Claims 1, 4-24 and 30 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Nielson* (U.S. Pat. No. 6,405,243) in view of *Reilly* (U.S. Pat. No. 6,427,164). Applicants respectfully traverse this rejection.

B. Applicants' Independent Claims

As provided in independent claims 1, 9, 15, and 20, Applicants claim (with emphasis added):

1. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;

responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database, **wherein the contacts database is stored within memory of the sending device;** and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

9. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information, and determining the identity of the user from the entry;

receiving the sending information entered by the user that identifies a destination to which information is to be sent by the sending device;

responsive to the entry, cross-referencing the sending information entered by the user with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending

information saved for that user, **wherein the contacts database is stored within memory of the sending device;**

providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information; and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

15. A sending information processing system, comprising:

logic configured to receive sending information entered by a user at a sending device that identifies a destination to which electrical information is to be sent;

logic configured to, **responsive to the entry, cross-reference the user-entered sending information with a contacts database** that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user in the database, **wherein the contacts database is stored within memory of the sending device;** and

logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

20. A sending information processing system, comprising:

means for receiving through entry by a user at a sending device sending information that indicates a destination to which information is to be sent;

means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the database for that user, **wherein the contacts database is stored within memory of the sending device;** and

means for automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

C. Discussion of the Rejection

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person

having ordinary skill in the pertinent art to fill the voids apparent in the applied reference.

In the present case, it is respectfully asserted that not every feature of the claimed invention is represented in the combination of the *Nielson* and *Reilly* references. In particular, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitations “responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” as recited in claim 1. The Office Action alleges that *Nielson* teaches the “responsive to the entry, cross-referencing the user-entered sending information with a contacts database” limitation, as noted below:

responsive to the entry, cross-referencing (see steps 501, 503 and 505 in Figure 5) the user-entered sending information with a contacts database (see Book File in step 501) that contains recipient sending information of the user to determine (step 505) if the user-entered sending information matches sending information saved in the contacts database;

In the communication filed on 2/2/2004, Applicants contended that the cross referencing in *Nielson* does not occur responsive to the entry. The Examiner disagrees. *Nielson*’s system is for forwarding email message (see the first sentence in abstract). In fact, all the procedures in *Nielson* are initiated when a user enters a sending message to be forwarded to a destination address. See the procedure in Figure 5 for example. The procedure in Figure 5 is initiated when a user enters sending information.

Applicants respectfully disagree. The lack of explicit support (*i.e.*, since the Office Action is alleging an inherency argument) for the Office Action’s assertion of a user entry at the sending device obscures the circumstances that occur post-entry. In other words, it is not clear from the *Nielson* reference what occurs in “response to” the alleged

entry input. Nor is it clear what prompts steps 501 and 503, as the specification in *Nielson* fails to inform one skilled in the art what “BEGIN” actually entails. For example, Applicants respectfully inquire where in the specification is there support for the statement, “The procedure in Figure 5 is initiated when a user enters sending information.” Applicants have included a portion of the specification (see col. 7, lines 15-25) pertaining to FIG. 5 below:

FIG. 5 illustrates the preferred steps for updating the sender's address book with the recipient's new email address. In step 501, the method retrieves the sender's address-book. In step 503, the method searches the retrieved address-book for the recipient's old email address. If not found (step 505), the method adds the recipient's new email address to the address book (step 507). If found (step 505), the method replaces the recipient's old email address with the recipient's new email address (step 509). Upon completion of steps 507 or 509, processing ends in the method of FIG. 5.

There is no mention that the cross referencing is responsive to an entry input. It is unclear from this excerpt what prompts the process illustrated in FIG. 5.

With regard to the limitation of claim 1, “wherein the contacts database is stored within memory of the sending device,” the Office Action alleges the following:

Although Nielson refers to the address book as the sender's address book in lines 10-14 of column 7, Nielson does not explicitly state that the sender address book is stored in the sender's sending device. Reilly teaches a sender's address book which is stored in a sending device 110 (see lines 54-58 of column 9 in Reilly). From the teaching of Reilly, it would have been obvious to a person of ordinary skill in the art to store a sender's address book in a sending device such that the address book can be used by the sending machine.

Applicants respectfully submit that the proposed combination would render the invention in *Nielson* unsatisfactory for its intended purpose, and thus the combination of references is improper. The system described in *Nielson* is for updating email addresses.

(See col. 1, lines 5-6) This is accomplished through a network-based, address-change server that maintains a database to perform a cross-reference from an old email address to a new email address (See col. 1 and 2, Summary of the Invention). Maintaining such a database at each sending device is not suggested in *Nielson*, and in fact, even prior art systems rely on a centric-database system (e.g., controlled by a system administrator, as described in Col. 1, Background of the Invention). Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* seeks to address.

With regard to the limitation of “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” the Office Action alleges that *Nielson* discloses this limitation:

automatically caching the user-entered sending information in the contacts database (see step 507) if the user-entered sending information has not been previously saved.

Applicants respectfully disagree. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21) The new email address is not **the** sending information entered at the sending device. Note the antecedent basis of the sending information in claim 1. Assuming the inherency of an entry is true, it would be the **recipient’s old email address, not the new email address** that is entered, as supported in the Office Action:

Receiving (see “BEGIN” in Figure 5) an entry (email message containing recipient’s old email address, inherent from step 503) input by a user...

Thus, according to the explicit limitations in claim 1, the sending information entered at the sending device is what is automatically cached. The Office Action correlates the

sending information with the recipient's **old email address** allegedly "entered" at a sending device. This old email address, if not saved already, must be the sending information automatically cached to meet the explicit claim limitations of claim 1. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations "responsive to the entry, cross-referencing the user-entered sending information with a contacts database," "wherein the contacts database is stored within memory of the sending device," or "automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved," Applicants respectfully request that the rejection to claim 1 be withdrawn.

With regard to independent claim 9, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitations "responsive to the entry, cross-referencing the sending information entered by the user with a contacts database," "wherein the contacts database is stored within memory of the sending device," or "automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved," as recited in claim 9. The Office Action alleges that *Nielson* teaches the limitation of "cross-referencing the sending information entered by the user with a contacts database." Applicants respectfully disagree. It is not clear from the *Nielson* reference what occurs in "response to" the "inherent" entry input. Nor is it clear what prompts steps 501 and 503, as the specification in *Nielson* fails to inform one skilled in the art what "BEGIN" means.

With regard to the limitation of claim 9, "wherein the contacts database is stored within memory of the sending device," Applicants respectfully submit that the

combination of *Nielson* and *Reilly* is improper in that such a combination would render the invention in *Nielson* unsatisfactory for its intended purpose. Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* sought to address

With regard to the limitation, “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully submit that this limitation is not disclosed, taught, or suggested in the combined references. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21) The new email address is not **the** sending information entered at the sending device. Thus, according to the explicit limitations in claim 9, the sending information entered at the sending device is what is automatically cached. The Office Action correlates the sending information with the recipient’s old email address allegedly “entered” at a sending device. This old email address, if not saved already, must be the sending information automatically cached to meet the explicit claim limitations of claim 9. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “responsive to the entry, cross-referencing the sending information entered by the user with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 9 be withdrawn.

With regard to independent claim 15, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitation “logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” as recited in claim 15. The Office Action alleges that *Nielson* teaches the limitation, “logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database.” Applicants respectfully disagree. It is not clear from the *Nielson* reference what occurs in “response to” the “inherent” entry input, nor is it clear what prompts steps 501 and 503. The specification in *Nielson* fails to teach one skilled in the art what “BEGIN” actually entails.

With regard to the limitation of claim 15, “wherein the contacts database is stored within memory of the sending device,” Applicants respectfully submit that the combination of *Nielson* and *Reilly* is improper in that such a combination would render the invention in *Nielson* unsatisfactory for its intended purpose. Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* sought to address.

With regard to the limitation, “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully submit that this limitation is not disclosed, taught, or suggested in the combined references. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address

book.” (See col. 7, lines 20-21) The new email address is not **the** sending information entered at the sending device. Thus, according to the explicit limitations in claim 15, the sending information entered at the sending device must be what is automatically cached. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 15 be withdrawn.

With regard to independent claim 20, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitations “means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” and “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” as recited in claim 20. The Office Action alleges that *Nielson* teaches the “means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database” limitation. Applicants respectfully disagree. It is not clear from the *Nielson* reference what occurs in “response to” the “inherent” entry input, nor what prompts steps 501 and 503.

With regard to the limitation of claim 20, “wherein the contacts database is stored within memory of the sending device,” Applicants respectfully submit that the combination of *Nielson* and *Reilly* is improper in that such a combination would render

the invention in *Nielson* unsatisfactory for its intended purpose. Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* sought to address.

With regard to the “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved” limitation, Applicants respectfully submit that this limitation is not disclosed, taught, or suggested in the combined references. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21) The new email address is not **the** sending information entered at the sending device. Thus, according to the explicit limitations in claim 20, the sending information entered at the sending device must be what is automatically cached. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 20 be withdrawn.

Applicants also submit that since the independent claims 1, 9, 15, and 20 are allowable, dependent claims 5-8 and 30, 10 and 12-14, 16-19, and 21-24, respectively, which contain the limitations of their respective base claims, are allowable as a matter of law.

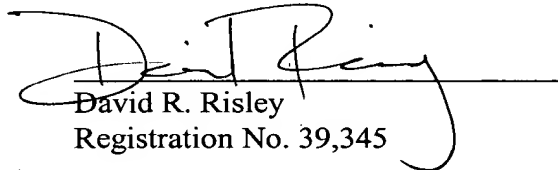
II. Canceled Claims

As identified above, claims 4 and 11 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

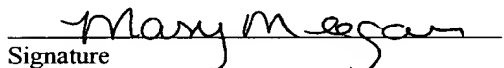
Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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